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EXAMINER	
WASSUM, LUKE S	
ART UNIT	**PAPER NUMBER**
2177	20

DATE MAILED: 03/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/866,425	VILCAUSKAS ET AL.	
	Examiner	Art Unit	
	Luke S. Wassum	2177	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 February 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *21-40* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21-40* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *24 May 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9 February 2004 has been entered.

Response to Preliminary Amendment

2. The Applicants' amendment, filed 9 February 2004, has been received, entered into the record and considered.

3. As a result of the amendment, claims 1-13 and 15-20 have been canceled, and new claims 21-40 have been added. Claim 14 had been previously canceled. Claims 21-40 are now presented for examination.

Priority

4. The Applicants' claim to domestic priority under 35 U.S.C. §119(e), to provisional application 60/207,698, filed 26 May 2000, is acknowledged. Since the subject matter of the parent provisional application encompasses that of the instant application and claims, a priority date of 26 May 2000 is hereby established.

The Invention

5. The claimed invention is drawn to a method of presenting advertisements in a computer system through the use of popunder windows. Alternative claimed embodiments are implemented in other media, such as a PDA, telephone, television and radio.

Claim Objections

6. Claims 23 and 33 are objected to because of the following informalities:

There appears to be a typographical error in the claims. In limitation (a) of the claims, the term 'off-link site' should be 'off-site link'.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claim 1 recites the limitation "said display" in limitation (a). There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham* v. *John Deere Co*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claims 21-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Landsman et al.** (U.S. Patent Application Publication 2003/0004804) in view of **Porn Rodeo** ("source code of www.pornrodeo.com as of 13 October 1999").

14. Regarding claim 21, **Landsman et al.** teaches a system for Internet advertising for use in a media capable of simultaneously maintaining a foreground window and at least one background window and capable of displaying a first browser in a said foreground window for selectively browsing the Internet substantially as claimed, said system comprising:

a) a script handler that invokes a post-session procedure in said first browser (see disclosure that HTML advertising tags are embedded in a web page, Abstract; see also Figures 2A and 2B); and

b) an event handler that receives, from an Internet address, a link to an advertisement and loads said advertisement (see paragraphs [0003], [0016], [0017], [0036]-[0038], [0087], [0095], [0107] and [0109]).

Landsman et al. does not explicitly teach a system wherein said post-session procedure opens a second browser in a background window while said first browser is simultaneously displayed in said foreground window, and wherein said advertisement is loaded into said second browser in said background window.

Porn Rodeo, however, teaches a system wherein said post-session procedure opens a second browser in a background window while said first browser is simultaneously displayed in said

foreground window, and wherein said advertisement is loaded into said second browser in said background window (see window.open and window.focus calls on page 1, lines 15-20).

It would have been obvious to one of ordinary skill in the art at the time of the invention to open a browser in the background and load the advertisement directly into the browser, since this would allow the display of the advertisement to the user (by moving the browser window to the foreground) without the need to open a new window, load any required player files, and load and render the advertisement, thus speeding the display of the advertisement to the user.

15. Regarding claim 31, **Landsman et al.** teaches a post-session advertising method for use in media capable of simultaneously maintaining a background window and a foreground window, said method comprising the steps of:

a) embedding post-session instructions into a first browser, said first browser for being displayed in said foreground window (see disclosure that HTML advertising tags are embedded in a web page, Abstract; see also Figures 2A and 2B);

b) said post-session instructions receiving, from an Internet address, a link to an advertisement (see discussion of a request for, and receipt of, an AdDescriptor file, a text file containing a list of file names and corresponding URLs at which these files reside, paragraphs [0103] through [0107]); and

c) loading said advertisement (see paragraph [0107]).

Landsman et al. does not explicitly teach a method wherein said post-session instructions open a second browser in a background window while said first browser is simultaneously displayed

in said foreground window, and wherein said advertisement is loaded into said second browser in said background window.

Porn Rodeo, however, teaches a method wherein said post-session procedure opens a second browser in a background window while said first browser is simultaneously displayed in said foreground window, and wherein said advertisement is loaded into said second browser in said background window (see window.open and window.focus calls on page 1, lines 15-20).

It would have been obvious to one of ordinary skill in the art at the time of the invention to open a browser in the background and load the advertisement directly into the browser, since this would allow the display of the advertisement to the user (by moving the browser window to the foreground) without the need to open a new window, load any required player files, and load and render the advertisement, thus speeding the display of the advertisement to the user.

16. Regarding claims 22 and 32, **Porn Rodeo** additionally teaches a system and method wherein said second browser is opened in response to a load-triggering event (see window.open call on page 1, lines 16-17, showing that the load-triggering event was the loading of the porn rodeo web page).

17. Regarding claims 23 and 33, **Porn Rodeo** additionally teaches a system and method wherein said load-triggering event comprises at least one of clicking on an off-site link, entering a new address, refreshing a web site, exiting a web site, and being redirected to a web site (see window.open call on page 1, lines 16-17, showing that the load-triggering event was the loading of

the porn rodeo web page, analogous to both refreshing a web site and being redirected to a web site, since both would entail the loading of the web page).

18. Regarding claims 24, 25, 34 and 35, **Landsman et al.** additionally teaches a system and method wherein said script handler delays invocation of said post-session procedure for a predetermined period of time, and wherein said script handler cancels invocation of said post-session procedure if a user loads a new web site in said first browser before said predetermined time period has elapsed (see disclosure of the timer based frame targeted advertisements, paragraph [0159]).

19. Regarding claims 26 and 36, **Landsman et al.** additionally teaches a system and method wherein said second browser is displayed in a foreground window after the occurrence of a view-triggering event (see paragraphs [0037] and [0038]).

20. Regarding claims 27 and 37, **Landsman et al.** additionally teaches a system and method including a focus timer that tracks the duration that said second browser is displayed in said foreground window (see paragraph [0050]).

21. Regarding claims 28 and 38, **Landsman et al.** additionally teaches a system and method wherein said media comprises one of a computer, a PDA, a cell phone and a television (see disclosure that the system is executed in a computer, Abstract).

22. Regarding claims 29 and 39, **Landsman et al.** additionally teaches a system and method wherein said event handler selects and returns one of a plurality of advertisements maintained at said Internet address (see paragraph [0104]).

23. Regarding claims 30 and 40, **Porn Rodeo** additionally teaches a system and method capable of opening a plurality of second browsers, each maintained in a separate background window, said event handler capable of receiving a link to an advertisement for each browser and loading a respective said advertisement into each said second browser while each said second browser remains in its respective said background window (see window.open and window.focus calls on page 1, lines 15-20, code that would open an additional background window each time the web page was refreshed).

Response to Arguments

24. Applicant's arguments filed 9 February 2004 have been fully considered but they are not persuasive.

25. Regarding the Applicants' arguments that the new claims are not anticipated by the **Porn Rodeo** reference, the examiner finds these arguments persuasive.

26. Regarding the Applicants' argument that the new claims are not anticipated by the **Landsman** and **Judson** references, the examiner agrees that the references do not explicitly teach a system wherein a new browser is opened in the background and the advertisement is loaded directly

into the browser while remaining in the background. However, the examiner believes that the claimed system is substantially equivalent to that taught by the **Landsman** reference.

The new independent claims contain limitations that an event handler receives a link to an advertisement and then loads the advertisement from that link. This is essentially an advertisement server operating in an advertisement network.

The **Landsman** reference teaches an analogous system, comprising an advertisement server operating in an advertisement network. The distinction between the reference and the claims, as pointed out in the Applicants' remarks, is that **Landsman** teaches a system wherein the advertisement is downloaded into the browser's cache memory, and is displayed when the user initiates the loading of another web page. The advertisement is displayed during the time that the web page is loading, called an interstitial. The claimed invention, on the other hand, calls for a new browser to be opened in the background and the advertisement to be downloaded directly into the background browser.

The examiner points out that the behavior of the two systems would be identical from the viewpoint of the user. The claimed invention (claims 26 and 36) cites that the background window is displayed in the foreground after the occurrence of a 'view-triggering event', which according to the specification at page 17, lines 4-15, could include a variety of events, including clicking on an off-site link. In this event, the background window is moved to the foreground and the advertisement displayed to the user. The **Landsman** reference teaches a system where as a result of the identical 'view-triggering event', a window (either a player or a browser) is opened in the foreground and the advertisement displayed. From the viewpoint of the user, popping a browser window from the

background to the foreground is indistinguishable from popping up a window whose content is pre-loaded in the browser's cache memory.

The feature of loading the advertisement directly into a browser instantiated in the background (as opposed to storing the advertisement in cache) would have been obvious to an ordinary artisan at the time of the invention, for the reasons stated in the new rejection of record.

27. Furthermore, the Applicants are advised that the examiner has found evidence that the company Advertisement Banners (.com) may have used pop-under windows in its SpecificPOP advertising network as early as January 2000, 5 months before the priority date of the instant application. The examiner is continuing to research this issue to determine if this is in fact the case.

Conclusion

28. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Rakavy et al. (U.S. Patent 5,913,040) teaches a method for selecting advertisements and other information from a computer network database based on user defined preferences and transmitting the selected advertisement in background mode over a communications link between the computer network and a local computer with minimal interference with other processes communicating over the communications link.

Landsman et al. (U.S. Patent Application Publication 2003/0028565) teaches a technique for implementing in a networked client-server environment such as the Internet, network distributed advertising in which advertisements are downloaded from an advertising server to a browser executing at a client computer, in a manner that is transparent to a user situated at the browser, and

subsequently displayed by the browser on an interstitial basis in response to a click-stream generated by the user to move from one web page to another.

Barkat et al. (International Publication WO 97/07656) teaches a method for selecting advertisements and other information from a computer network database based on user defined preferences and transmitting the selected advertisement in background mode over a communications link between the computer network and a local computer with minimal interference with other processes communicating over the communications link.

Brunner ("Tools of the Trade: Unicast: Good Things Come to Those Who Wait") teaches Unicast's AdController, a push interstitial platform which pre-caches large advertisement files when the network activity is quiet, such as when a user is reading content, and then after the ad is fully loaded, it plays as a pop-up window when the user clicks on a new hyperlink and is waiting for that page to load.

Kaplan ("Unicast Set to Launch Next Wave of Internet Advertising Multi-Platform 'Transitionals' May Represent an Alternative to Banners") teaches the introduction of new online commercials called transitionals that beam their messages to users during the time it takes for a web page to download after a visitor has clicked on its link.

Unicast ("AdController: Introduction") teaches the details of the operation of Unicast's AdController product.

ExitExchange ("ExitExchange Quick Tour Page 1") teaches the use of RWMS Technology™ whereby advertisements are opened in the background.

ExitExchange ("General Questions") teaches the use of RWMS Technology™ whereby advertisements are opened in the background.

The following references, while not qualifying as prior art, are also of interest.

Moylan ("New Pop-Under Web Advertising Earns Attention") teaches the use of pop-under advertisements by X10, including characterizing pop-under ads as "a simple twist on pop-up ads", and discloses that the New York Times began running pop-under ads on 11 May 2001.

RadioHorizon ("Byproduct of Collapsing Online Ad Market: Now You Can Buy the Entire Internet") teaches the use of pop-under windows in Internet advertising.

Olsen ("Online Ads Get in Your Face") teaches the use of pop-under windows in Internet advertising.

Bartlett ("Pop-Under Web Advertising Increasingly Popular, Draws Ire") teaches the use of pop-under windows in Internet advertising, including the fact that Fastclick.com did not invent the pop-under window, and that Fastclick.com began serving pop-under advertisements in November of 2000.

Tessler ("Marketers Grab Attention by Putting Web Ads into Motion") teaches a number of new Internet advertising techniques more effective than the traditional banner ad, including pop-under ads.

Featherly ("How Annoying Can Online Ads Get?") teaches the use of pop-under windows in Internet advertising.

Swett ("Internet Advertisers Turn to Pop-Under Windows to Generate Sales") teaches the use of pop-under windows in Internet advertising.

Neuborne ("Irksome—and Effective: Desktop 'Pop-Unders' Allow for More Complex Ads, and Healthy Response Rates") teaches the use of pop-under windows in Internet advertising.

Advertisement Banners ("About Us") teaches that the company launched the SpecificPOP advertising network in January 2000, a network that specializes in the strategic placement of the Internet's highest performing ad unit, the pop-under.

Luna ("Internet Upstarts Savor Court Victory Over Security Camera Ads") teaches the verdict in a lawsuit in which AdvertisementBanners.com was awarded compensatory damages of $4.3 million after X10 failed to pay the company $564,000 called for in a July 2001 business contract.

The Associated Press ("Brothers Win 'Web Bully' Lawsuit") teaches the verdict in a lawsuit in which AdvertisementBanners.com was awarded compensatory damages of $4.3 million after X10 failed to pay the company $564,000 called for in a July 2001 business contract.

Chuang et al. ("Bankrupcy of Wireless Camera Firm May Hurt California Brothers' Suit") teaches that the company AdvertisementBanners was launched in 1999, and concentrated on pop-under advertisements.

SpecificPOP ("About SpecificPOP") teaches that the SpecificPOP advertising network was launched in 2000, and specializes in pop-under advertising on the Internet.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke S. Wassum whose telephone number is 703-305-5706. The examiner can normally be reached on Monday-Friday 8:30-5:30, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on 703-305-9790. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

In addition, INFORMAL or DRAFT communications may be faxed directly to the examiner at 703-746-5658.

Customer Service for Tech Center 2100 can be reached during regular business hours at (703) 306-5631, or fax (703) 746-7240.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Luke S. Wassum
Art Unit 2177

lsw
3 March 2004